REMARKS

This application, as amended herein, contains claims 1-18. Claims 18 and 20 previously canceled. No amendments have been made to the claims. Those previously presented are now represented without underlining and strikethrough, which may be found in the Applicant's previous paper.

These Remarks are divided into two parts. The first part deals with the fact that, as a matter of law, the Examiner cannot rely on U.S. Patent No. 6,748,367 to Lee in rejecting the claims. Then, in the second part, even though the Examiner has made no specific rejection of the claims on the basis of the Lee provisional, the deficiency of the Lee provisional is demonstrated.

It is pointed out that the failure to provide specific grounds for rejection based on the Lee provisional is a clear violation of USPTO policy. If such rejection is possible, the Examiner can and must cite to the Lee provisional, which became a public document as soon as the Lee regular patent application was published, as linked to in the Public PAIR system. The undersigned could find no reference in the MPEP to any provision prohibiting the Examiner from citing a publicly available provisional as a reference. Further, there is no practical difficulty to citing to portions of a provisional application. In demonstrating the deficiency of the Lee provisional on the merits, the undersigned has extensively cited specific portions below.

The failure to cite specific portions of the Lee provisional, if such can be cited, is a situation that is clearly unfair to the Applicant, as it is difficult to know the exact nature of what is being considered in the Lee provisional and how it is being applied.

This is especially important in this case, as the Lee provisional and the application that issued as the Lee patent are very dissimilar in content and form. The provisional is merely an invention disclosure form, and does not contain all of the teachings of the Lee patent. It is the duty of the Examiner to assess what the Lee provisional does contain, and base rejections on that document with the same precision as in any other rejection. Anything else is a clear violation of the due process to which the Applicant is entitled. Further, making such a rejection final just adds to the injury to Applicant.

Claims 1, 3, 8, 10-15 and 18 were rejected as being obvious over U.S. Patent No. 6,748,367 to Lee in view of Abecassis. Claim 2 was rejected as obvious over Lee in view of Abecassis and further in view of Lai. Claims 4-6 were rejected as obvious over Chang in view of Abecassis, in view of Lee. Claim 7 was rejected as obvious over Chang in view of Abecassis in view of Lee and further in view of Lai. Claim 9 was rejected as obvious over Lee in view of Chang and further in view of Abecassis. Finally, claims 16-17 were rejected as obvious over Abecassis in view of Lee. These rejections are all respectfully traversed for the reasons set forth below.

Part 1

All of the rejections are based at least in part on Lee (U.S. Patent No. 6,748,367). This is simply wrong as a matter of law, because the Examiner cannot rely on U.S. Patent No. 6,748,367 to Lee. The verified English language translation of the application from which priority, under 35 U.S.C. 119, is claimed has been submitted, to support and perfect Applicant's claim to priority. For the reasons set forth in previous papers submitted by Applicant, it is respectfully pointed out to the Examiner that Lee is not a proper reference against the present application. The Examiner must ignore U.S. Patent No. 6,748,367, to Lee as if it did not exist, for the following reason:

The priority date to which the applicant of the present invention is entitled (March 30, 2000) based on the filing of a corresponding application in Japan, is prior to the filing date of the regular application of Lee (serial number 09/667,832, filed on September 21, 2000, which issued as U.S. Patent No. 6,748,367).

Specifically, quoting the provisions of MPEP Section 201.15, to which the Examiner is respectfully referred:

> In those cases where the applicant files the foreign papers for the purpose of overcoming the effective date of a reference, a translation is required if the foreign papers are not in the English language. When the examiner requires the filing of the papers, the translation should also be required at the same time. This translation must be filed together with a statement that the translation of the certified copy is accurate. When the necessary papers are filed to overcome the date of the reference, the examiner's action, if he or she determines that the applicant is not entitled to the priority date, is to repeat the rejection on the

reference, stating the reasons why the applicant is not considered entitled to the date. **If it is determined that the applicant is entitled to the date, the rejection is withdrawn in view of the priority date.**

If the priority papers are already in the file when the examiner finds a reference with the intervening effective date, the examiner will study the papers, if they are in the English language, to determine if the applicant is entitled to their date. **If the applicant is found to be entitled to the date, the reference is simply not used but may be cited to applicant on form PTO-892.** If the applicant is found not entitled to the date, the unpatentable claims are rejected on the reference with an explanation. If the papers are not in the English language and there is no translation, the examiner may reject the unpatentable claims and at the same time require an English translation for the purpose of determining the applicant's right to rely on the foreign filing date. **(emphasis added)**

Thus, it is submitted that, as a matter of law, the rejections are wrong, and must be withdrawn. The Examiner must simply put out of her mind, and ignore, U.S. Patent No. 6,748,367 to Lee in examining the present application. Further, if the Examiner bases a rejection on the Lee provisional, the Examiner must cite to specifics in the Lee provisional, and not to U.S. Patent 6,748,367 to Lee, which is not prior art.

Part 2

The Examiner relies on Lee for the teaching of the use of a temporary account. The previous Examiner's Response to Arguments were duly noted, and the claims amended in response. A careful review of Lee's provisional application, shows that the provisional application does not teach or even remotely suggest the use of a temporary account with a single vendor, said account holding only a required amount of money for said transaction, for transfer to

a fixed destination, for a single designated or predetermined transaction, such as, for example, one that is set up for the a current transaction, and then is deleted after the transaction has been completed (underlined language in all independent claims in this application).

Lee's provisional application is directed to an Internet teller machine, which generates digital tokens or digital cash that may be pasted on to a vendor's payment form (provisional specification, page 5 of 10, top). Tokens are moved to a claim pool (provisional specification, page 5 of 10, top); which is not a temporary account for a single designated or predetermined transaction with a single vendor, said account holding only a required amount of money for said transaction, for transfer to a fixed destination, for a single designated or predetermined transaction, as set forth in the independent claims of the present application. In fact, the digital tokens of Lee may be used with any merchant for any transaction, for the reasons noted below.

While certain security precautions are suggested in the Lee provisional, the digital token may be subject to loss or misdirection under certain circumstance. In fact, the Lee provisional, at page 6 of 10, four lines from the bottom, says: "Only one vendor (first come first serve), will be able to claim the Internet cash that was presented by the payor." It also says, in the last line on the same page: "Intruder steals and claims the money before the legitimate vendor does". (emphasis added)

Thus, the previous Examiner's assertion on page 16 of the office action of October 19, 2006 that:

> "Furthermore these tokens are designated and encrypted for a specific vendor, for a specific transaction and cannot be used for any transaction as claimed by applicant. Only the specific vendor, with his specific encryption key can access the designated "proper combination of funds."

is simply wrong. The previous Examiner was, and the present Examiner is, referred to Format of Internet Cash, page 4 of 10 of the Lee provisional. The Lee provisional actually states:

> "Internet Bank issues Internet-cash, which is a digital token that carries a financial value. However, it does not contain information of payer or payee like a check." (emphasis added)

Finally, the token are available to paste on a vendor's form, not just one specific vendor's form. This follows from the statement on page 5 of 10, at line 8 of the Lee provisional application that:

> The user may keep any left over or unused token in his (her) local file or wherever one desires to keep:

Thus, the present invention, as set forth in independent claims 1, 4, 8, 10, 13, 16 and 18, patently distinguishes from the approach of the Lee provisional. The present invention sets up a temporary account for use only for the transaction being conducted. There is no "pool" of funds. The funds are not in the form of digital cash, which can be used for any transaction, but instead the funds are held only for a specific transaction.

Furthermore, as specifically recited in claim 1 (and by analogous language in the other independent claims), the Lee provisional does not teach or suggest fourth apparatus for providing a verification by said vendor, via said network, which verifies the contents of said temporary account and locks said temporary account to limit access by said purchaser. This provides both more security and convenience to the vendor. Applicant's invention, as set forth in the independent claims is not taught or suggest by the approach in the Lee provisional application. It is thus submitted that claims 1, 4, 8, 10, 13, 16 and 18 are directed to patentable subject matter.

The cited portions of Abecassis add nothing to the Lee provisional application to render Applicant's claims obvious. There is nothing in Abecassis to teach or suggest a fourth apparatus for providing a verification by said vendor, via said network, which verifies the contents of said temporary account and locks said temporary account to limit access by said purchaser. The cited portions of Abecassis are directed to an escrow account over which the purchaser has control.

The remaining claims depend from one of the independent claims discussed above. These claims recite further elements, which in combination with the elements of the independent claims, are not shown or suggested in the art of record.

With specific reference to claim 7, it is noted that the rejection relies on a combination of four separate references. The rejection does not take into account the synergistic combination of the various security procedures of locking an account with keys, with the use of a temporary dedicated account for a specific transaction, to thus provide a very high level of security. It is submitted that to combine the four references is using impermissible hindsight, wherein references have been chosen and assembled after knowledge of Applicant's invention. For the reasons set forth above, and for those set forth with respect to the independent claims, it is submitted that claim 7 is patentable.

Conclusion

First, as noted above, the digital tokens of the Lee provisional are not a temporary account of the type specified in the independent claims, as noted above. Further, there is no teaching or suggestion in the Lee provisional, that the digital tokens are of a required amount for a specific transaction. In fact, page 5 of Lee's provisional application (lines 5-6) teaches a proper combination of Internet cash tokens to meet the requested amount. This is because the tokens would be in specific

cash amounts (as with ordinary cash) for use in any transaction, and thus there is no specific amount in the pool for any predetermined transaction. The Lee provisional does not teach or suggest only a required amount of money for the single designated transaction, as set forth in the independent claims. In addition, the digital tokens of the Lee provisional can be used with any vendor, and there is no teaching or suggestion that the account can only be used to transfer a required amount of money for the single designated transaction to a fixed destination (for example, a specific merchant), as specifically set forth in the independent claims.

The Examiner has admitted that in order to reject the claims, the teachings of the Lee patent are needed, and relies on the Lee patent. However, as demonstrated herein, such reliance is contrary to law. Further, as demonstrated herein, the teaching of the Lee provisional application, which has drastically different content than the Lee patent, do not teach or suggest Applicant's invention, whether taken alone, or in combination with the other art of record. Allowance of this application is respectfully requested.

A check in the amount of $460 for a two-month extension of time is enclosed.

Respectfully submitted,

David Aker 1/22/2008

David Aker, Reg. No. 29,277 Date
23 Southern Road
Hartsdale, NY 10530
Tel. No. 914 674-1094 Fax No. 914 479-5304
Mobile 914 426-1775